REMARKS

Claims 1-27 are pending in the application, claims 19-27 being new.

Claims 1-3, 5 and 10-18 over Borland

In the Office Action, claims 1-3, 5 and 10-18 were rejected under 35 U.S.C. §102(e) as allegedly being obvious over U.S. Patent No. 6,343,217 to Borland ("Borland"). The Applicant respectfully traverses the rejection.

Claims 1-9 recite an **unbalanced** coding scheme wherein digital audio transmitted in a first direction over a full-duplex audio path is encoded using a first encoding scheme **different** from a second encoding scheme used to encode digital audio transmitted over the full-duplex audio path in a second direction opposite the first direction. Claims 10-13 recite providing a second radio frequency bandwidth **different** from a first radio frequency bandwidth, for transmission of encoded digitized audio data from a remote handset to a base unit. Claims 14-16 recite a base unit having an audio encoding scheme of a first type, and a remote handset having an audio encoding scheme of a second type **different** from the first type. Claims 17 and 18 recite an **unbalanced** coding scheme wherein digital audio transmitted in a first direction over a full-duplex audio path is encoded using a first analog-to-digital conversion precision **different** from a second analog-to-digital conversion precision used to encode digital audio transmitted over the full-duplex audio path in a second direction opposite the first direction.

Clearly, the invention requires an unbalanced communication path, the data in one direction being of a different type or encoding scheme that the data in the opposite direction.

The Examiner repeatedly cites the paragraph bridging cols. 5 and 6 of Borland for allegedly supporting an inherency in rejecting all claims, i.e., that Borland **inherently** discloses an unbalanced coding scheme wherein digital audio transmitted in a first direction over a full-duplex audio path is encoded using a first encoding scheme **different** from a second encoding scheme used to encode digital audio transmitted over the full-duplex audio path in a second

direction opposite the first direction. (See, e.g., Office Action at paragraph bridging pages 2 and 3).

Under the doctrine of necessary inherency, anticipation may be established when a single prior art reference fails to disclose the claimed invention ipsissimis verbis, but the natural and invariable practice of the reference would necessarily inherently meet all the elements of the claim. See, e.g., Verdegaal Bros., Inc. v. Union Oil Col. of Cal., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 227 USPQ 245 (Fed. Cir. 1985); Ethyl Molded Products Co. v. Betts Package Inc., No. 85-111 1032 (D.C.E.D. Kent. 1988). The doctrine of inherency is available only when the inherency can be established as a certainty; probabilities are not sufficient. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); In re Chandler, 254 F.2d 396, 117 USPQ 361 (CCPA 1981); Ethyl Molded Prod. Co. at 1032.

As evidence of an alleged inherency, the Examiner interprets Borland as being capable of switching between various coding schemes, citing col. 5, lines 13-20. This particular passage of Borland discloses use of a switch 117 that toggles between two **operation** modes for handset 110. In a "voice" mode, handset 110 communicates acoustic signals received through a microphone and produces by a speaker. In a "data" mode, handset 110 communicates data signals through a modem port 115.

The Examiner misunderstands Borland. In a DATA mode, the signal would NOT BE ENCODED, whereas in an acoustic mode, data WOULD be encoded, according to Borland. It is well known that modem signals are not well reproduced using acoustic encoding algorithms. Thus, Borland does NOT disclose at col. 5, lines 13-20 the use of **two** encoding schemes, one different from the other. Rather, it merely discloses the use, or non-use, of a single encoding scheme.

Moreover, the Examiner appears to be interpreting the claims as reading on some sort of non-functional transitional state of Borland when the handset switches to a coding scheme in which the base is not using. See, e.g.,

the Office Action at 3, first paragraph, second paragraph, page 4 first full paragraph, etc.

The Examiner should be reminded that Borland discloses a DIGITAL cordless telephone, and as such changes to operational modes occur substantially simultaneously and in BOTH a handset and a base unit when both units are ready for the change-over. Borland is not an analog system that somehow has a non-functional transitional state where one codec is switched before the other, and continues to operate in such a state.

Even so, and more importantly, Borland does NOT disclose, teach or even suggest the use of DIFFERENT encoding schemes in opposite directions of a full-duplex path. In particular, the Examiner's interpretation of the passage in Borland at col. 5, line 60 to col. 6, line 8 repeatedly cited by the Examiner as support for an INHERENT property of Borland is NOT what the Examiner suggests.

That is, Borland discloses at col. 6, lines 5-8 that in "one embodiment, a user may switch between quanization schemes, providing flexibility for the transceiver to better communicate human voice or certain types of modem signals." The Examiner somehow reads this disclosure to mean that only ONE side of the full-duplex communication path would change quantization scheme. There is absolutely no support for such an interpretation.

Moreover, the use of two **different** encoding schemes goes to the **heart** of the present invention. This is an important, novel and distinct feature. It is respectfully submitted that the Examiner's allegation of 'inherency' at the point of novelty of the present invention is improper.

For at least all the above reasons, claims 1-3, 5 and 10-18 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 4 and 6-9 over Borland

Claims 4 and 6-9 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Borland. The Applicant respectfully traverses the rejection.

The Examiner relies upon the earlier rejection of the independent claim 1 in support of the rejection of dependent claims 4 and 6-9, citing an obvious teaching of Borland. However, the use of **inherency** at all is entirely improper with respect to a section 103 rejection. The concept of inherency has no place in determinations of obviousness under section 103, as opposed to anticipation under section 102, because "it confuses anticipation by inherency, i.e., lack of novelty, with obviousness, which, though anticipation is the epitome of obviousness, are separate and distinct concepts." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984); See also In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775-76 (Fed. Cir. 1983)

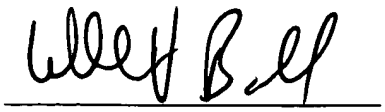
The foundation for the section 103 rejection of claims 4 and 6-9 being improperly based on an allegedly **inherent** feature of Borland, it is respectfully requested that the improper rejection be withdrawn.

Accordingly, for at least all the above reasons, claims 4 and 6-9 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,



William H. Bollman
Reg. No. 36,457

Manelli Denison & Selter PLLC
2000 M Street, NW
Suite 700
Washington, DC 20036-3307
TEL. (202) 261-1020
FAX. (202) 887-0336